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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,965	09/15/2000	GETHER IRICK JR.	05015.0365U1	3021

23859 7590 04/17/2003

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127 PEACHTREE STREET N E  
ATLANTA, GA 30303-1811

EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

18

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/662965

Applicant(s)

Irlick Jr. et al

Examiner

Shant

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on February 27, 2003

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-5, 7-9, 12, 13, 16, 20, 22, 24-28 is/are pending in the application.

Of the above claim(s) 8, 12, 13, 16, 20 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5, 7, 9, 22, 24-28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9-11, 14, 15, 17, 18, 21, 22 and 24-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blumenthal. The rejection is applied as in the previous Office action. Aliphatic-aromatic polyester (1) encompasses the sulfonated polyester of the reference. While Blumenthal does not disclose that articles formed from the compositions have a delayed biodegradation rate when compared to articles formed from compositions without the terpene-phenol resin, recitation of a newly discovered property inherently possessed by the methods and articles of the reference does not distinguish over the reference and where the reference methods and articles are substantially the same as the claimed method and article, the burden is upon applicant to demonstrate that the reference articles do not possess the claimed property. See *In re Best* 195 USPQ 430 (CCPA 1977) and *In re Tomlinson* 150 USPQ 622 (CCPA 1966).

Claims 1-5, 9-11, 14, 15, 17, 18, 21, 22 and 24-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Schoenberg,

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Rutherford, Iovine and Kauffman. The rejection is applied as in the previous Office action. Aliphatic polyester (2), second formula, encompasses the polyesters of the references. While the references do not disclose that articles formed from the compositions have a delayed biodegradation rate when compared to articles formed from compositions without the terpene-phenol resin, recitation of a newly discovered property inherently possessed by the methods and articles of the reference does not distinguish over the reference and where the reference methods and articles are substantially the same as the claimed method and article, the burden is upon applicant to demonstrate that the reference articles do not possess the claimed property. See *In re Best* 195 USPQ 430 (CCPA 1977) and *In re Tomlinson* 150 USPQ 622 (CCPA 1966).

Claims 1-5, 9-11, 14, 15, 17, 18, 21, 22 and 24-28 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese '903. The rejection is applied as in the previous Office action. Aliphatic polyester (2), second formula, encompasses the polyester of the reference. While Japanese '903 does not disclose that articles formed from the compositions have a delayed biodegradation rate when compared to articles formed from compositions without the terpene-phenol resin, recitation of a newly discovered property inherently possessed by the methods and articles of the reference does not distinguish over the reference and where the reference methods and articles are substantially the same as the claimed method and article, the burden is upon applicant to demonstrate that the reference articles do not possess the claimed property. See *In re Best* 195 USPQ 430 (CCPA 1977) and *In re Tomlinson* 150 USPQ 622 (CCPA 1966).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

P. Short

April 9, 2003

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**PATRICIA A. SHORT  
PRIMARY EXAMINER**

*Patricia A. Short*